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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,392

09/01/2006

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6768/PCT

9572

6858 7590 01/19/2011  
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EXAMINER

DUCHENEAUX, FRANK D

ART UNIT

PAPER NUMBER

1788

MAIL DATE

DELIVERY MODE

01/19/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,392	<b>Applicant(s)</b> NENCIONI ET AL.	
	<b>Examiner</b> FRANK D. DUCHENEAUX	<b>Art Unit</b> 1788	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 63-126 is/are pending in the application.
- 4a) Of the above claim(s) 86-124 and 126 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63-85 and 125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/2010 has been entered.

### **Response to Amendment**

2. Applicant's arguments, see pages 20-23, filed 5/4/2010, with respect to the restriction of claim 125 having been constructively elected by original presentation have been fully considered and are persuasive. The restriction of claim 125 has been withdrawn and claim 125 has been rejoined with the elected invention of claim 63 and its dependencies.

3. Applicant's arguments, see pages 23-26, filed 5/24/2010, with respect to the rejection of claims 63-85 under 35 U.S.C. 112, 1st paragraph have been fully considered and are persuasive. The rejection of claims 63-85 has been withdrawn, except as noted below.

4. Applicant's arguments, see pages 26-27, filed 5/24/2010, with respect to the rejection of claims 63-85 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph have been fully considered and are persuasive. The rejection of claims 63-85 has been withdrawn.

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 63-85** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 63 recites that the first ply and the second ply are adhesive-together at least at said areas where said first adhesive is applied. The examiner notes that the specification provides no support for the first and second plies to be adhesive-bonded, or glue-bonded, together; only that each ply is glued to a third, interposing ply.

7. **Claim 125** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed does not support a third ply that is “alternatively” bonded at said first areas to said first ply and at said second areas to said second ply (see also rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph below).

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8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 63-85** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding claim 63**, it is unclear from the claim limitations how the 1<sup>st</sup> and 2<sup>nd</sup> plies can be adhesive-bonded together when the claim limitations require that a third ply is interposed between said 1<sup>st</sup> and 2<sup>nd</sup> plies.

**Regarding claim 66**, the recitation of second adhesive applied “at a level” of the protuberances is ambiguous as it is unclear from the claim limitations where precisely said adhesive is applied, i.e., inside or outside of the ply, sides of the protrusion or at the most inward face of said protrusion.

**Regarding claim 74**, the recitation of background pattern of the second ply flattened “at a level” of the protuberances forming the first decorative elements is ambiguous as it is unclear from the claim limitations where precisely said level is located, i.e., sides of the protrusion or at the most inward face of said protrusion or elsewhere.

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**Regarding claim 75**, the recitation of protrusions defining said second decorative elements flattened “at a level” of the respective protuberances defining the first decorative elements is ambiguous as it is unclear from the claim limitations where precisely said level is located, i.e., sides of the protrusion or at the most inward face of said protrusion or elsewhere.

**Regarding claim 75**, within the scope of the invention, it is unclear how the first and second decorative elements, which are formed from their respective protuberances, can be intercalated as required by current claim 63, and simultaneously at least some of second decorative elements are flattened by protuberances defining the first decorative elements.

**Regarding claim 76**, it is unclear how a 3<sup>rd</sup> ply interposed between 1<sup>st</sup> and 2<sup>nd</sup> plies, wherein the 1<sup>st</sup> and 2<sup>nd</sup> plies have intercalated protuberances, can be devoid of embossing as the limitations of claim 63 would impart a degree of embossing to the 3<sup>rd</sup> ply (see figures 3 and 7 to which the applicants point for support for the “intercalating” amendment).

10. **Claim 125** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding claim 125**, it is unclear from the claim limitations (see also the specification at line 7, page 10 and at line 10, page) how the first and second elements are "partly" staggered.

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**Regarding claim 125**, it is unclear from the claim limitations in what manner the third ply is "alternatively" bonded to the 1<sup>st</sup> and 2<sup>nd</sup> plies as no previous manner of bonding was recited to which the alternative manner can be compared.

### **Claim Rejections - 35 USC § 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. **Claims 63-76 and 82** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1).

**Regarding claims 63, 68-73, 76 and 82**, Ruppel teaches compound sheets made of absorbent paper (multi-ply web material) (abstract) comprising sheets (1) and (2) (1<sup>st</sup> and 2<sup>nd</sup> ply) having deep embossing patterns (3) (1<sup>st</sup> and 2<sup>nd</sup> pattern...protuberance projecting inward) having a height of 0.5 to 2.5 mm, a density of 3 to 19 bosses/cm<sup>2</sup>, which overlaps that presently claimed,

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and a cross section of an oval, circle etc. (column 2, lines 42-52), which said density and emboss height provides improved touch, flexibility and appearance (column 1, lines 38-45).

As set forth in MPEP 2144.05, in the case where the claimed range “overlap or lie inside ranges disclosed by the prior art”, a prima facie case of obviousness exists, In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Ruppel also teaches that both sheets comprise a second embossing pattern (4) of smaller bosses (1<sup>st</sup> and 2<sup>nd</sup> ply background pattern) having a height between 0.1 to 0.30 mm (less than the height of the 1<sup>st</sup> and 2<sup>nd</sup> decorative pattern), and a density larger than that of the first pattern in a ratio of at least 2 (density greater than 8 protuberances/cm<sup>2</sup>) (column 2, lines 53-64). The examiner notes that the embossments of the second embossment pattern as disclosed by Ruppel, by virtue of its existence, would necessarily have a geometrical form as presently claimed.

Ruppel continues to teach that a third sheet (third ply) can be sandwiched (lamination of current claim 82) between (interposed, devoid of embossing) the two embossed sheets without exceeding the scope of the invention (column 2, lines 65-67), while figure 2 (see also column 3, lines 1-3) of the disclosed invention demonstrates that the embossments (3) of sheet (1) are arranged in an intercalating manner with the embossments (3) of sheet (2), and that the two plies are linked (1<sup>st</sup> and 2<sup>nd</sup> plies adhesively bonded together) via glue (first adhesive) on the top of the bosses of the first pattern (corresponding protuberances’ areas of the 1<sup>st</sup> decorative elements) of one of the sheets (column 3, lines 3-5).

The examiner notes that the embossments (3) of sheets (1) and (2) are at least different from one another in that they are projecting in opposite directions to one another (see figure 2),



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and/or that an oval cross section and a circular cross section for the embossments of sheets (1) and (2) (see column 2, lines 42-52), respectively, would also teach first decorative elements and second decorative elements that are different from each other as presently claimed. It is noteworthy (see In re Seid below) that a choice between said cross sections would be obvious to the skilled artisan.

Claim limitations relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art (In re Seid 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

The examiner also notes that the intercalated manner of the embossments (3) of the reference would necessarily teach that the areas of a second ply corresponding to areas of a first ply having an embossment would be devoid of a protuberance as presently claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to select a density of embossments (3) identical to that presently claimed, which said embossments (3) of the two outer sheets (1) and (2) having different cross sectional shapes, towards an absorbent paper of compounded sheets providing improved touch, flexibility and appearance as in the present invention.

**Regarding claims 64-67**, the examiner notes, as set forth above, that the two plies (1) and (2) are linked via glue on the top of the bosses of the first pattern of one of the sheets, and that the tips of the two sheets (second adhesive applied to second ply) are coated with glue (column 1, lines 33-37); and that a third sheet can be interposed between the two plies (1) and

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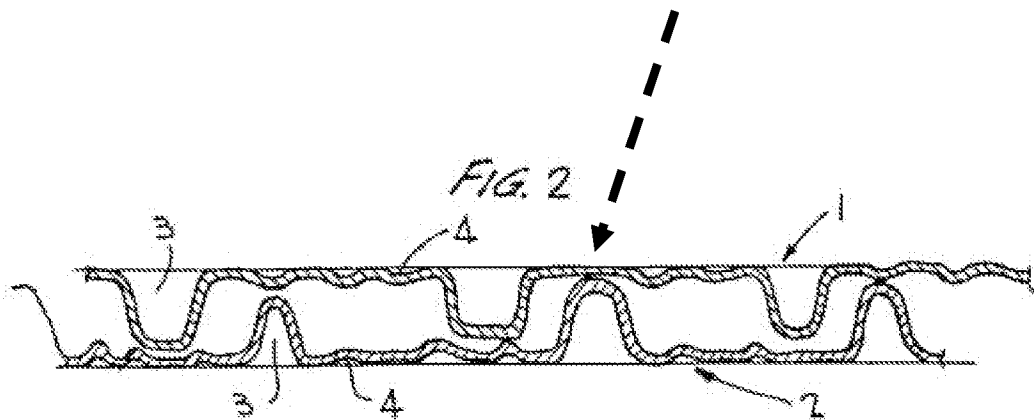
(2), which would intrinsically provide a reciprocal glue adhesion between the three sheets of the disclosed invention as presently claimed.

Although Ruppel does not disclose a first adhesive applied to a third ply (current claim 64), which is made to seep at least partly through said third (current claim 65), it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

As set forth above, Ruppel teaches a first and second ply bonded to a third ply in areas of the bosses of the first pattern, which is identical to the presently claimed adhesively bonded, three-ply construct.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Ruppel meets the requirements of the claimed composition, Ruppel clearly meets the requirements of the present claims.

**Regarding claims 74-75**, the examiner notes that following figure, taken from the figure 2 of the Ruppel reference,



wherein it is noted that the emboldened, hashed arrow (provided by the examiner) points to a portion of the top sheet (1) that is flat in the area where the embossment (3) of the lower sheet (2) is located.

While the Ruppel reference does not disclose that any or some of the second embossing pattern of the top sheet (1), or any or some of the embossments of the first embossing pattern of either sheets (1) or (2), is flattened by an embossment (3), it is the examiner's position that the configuration of figure 2 provides a flattened portion of the upper sheet corresponding to embossment (3) in a manner identical to that presently claimed, and absent evidence of criticality regarding the presently claimed process and given that Ruppel meets the requirements of the claimed invention, Ruppel clearly meet the requirements of the present claims.

14. **Claims 77-78** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1) in view of Hollenberg et al (US Patent 6221211 B1).

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**Regarding claims 77-78**, Ruppel teaches compound sheets made of absorbent paper as in the rejection of claim 63 above. Ruppel is silent to a colored third ply and a third ply with a printed pattern.

However, Hollenberg teaches multi-ply tissues having internal indicia (title) comprising a multi-ply tissue comprising two outer plies and one center ply, said center ply containing colored or patterned indicia which is visible through both outer plies (column 1, lines 49-52) and also suitable are solidly colored center plies (column 2, lines 19-21).

Hollenberg continues to teach facial and bath tissues provided with a distinctive visual cue or indicator accomplished by printing, dyeing or otherwise coloring an internal surface of one or more plies of a multi-ply tissue, which indicates that such tissues contain unique ingredients or properties (column 1, lines 20-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Ruppel and Hollenberg in order to further provide decorative features to an absorbent paper as in the present invention.

15. **Claims 79-81** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1) in view of Roussel et al (US 6599614 B1).

**Regarding claims 79-81**, Ruppel teaches compound sheets made of absorbent paper as in the rejection of claim 63 above. Ruppel is silent to a first ply, a second ply and a third ply are

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composed of two or more layers, which said two or more layers are joined to one another via mechanical ply-bonding.

However, Roussel teaches a three ply absorbent paper product (title) including first and second external embossed plies and central or third smooth unembossed ply (column 4, lines 48-51), and that each ply includes one or more layers forming a laminate (two or more layers) (column 5, lines 12-13).

Although Ruppel and Roussel do not disclose mechanical ply-bonding as recited in claim 80, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Ruppel and Roussel meets the requirements of the claimed structure, Ruppel and Roussel clearly meets the requirements of the present claims.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Ruppel and Roussel references to provide a three ply absorbent paper, wherein at least a central third ply is formed of at least two layers, towards an absorbent paper having, inter alia, increased absorbency and strength as in the present invention.

16. **Claim 83** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1) in view of Biagiotti (US Patent 6755928 B1).

**Regarding claim 83**, Ruppel teaches compound sheets made of absorbent paper as in the rejection of claim 63 and 66 above. Ruppel is silent to a first and second adhesive that chromatically different from each other.

However, Biagiotti teaches a method and device for producing an embossed web material and product made (title) wherein the method includes producing a soft product and increasing the decorative effect of the embossing by combining it with the use of colored adhesives (column 2, lines 22-26) so that ornamental motifs stand out from the background of the web material.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Ruppel and Biagiotti references to provide a plurality of colored adhesives towards a more decorative absorbent paper with varied chromatic possibilities as in the present invention.

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17. **Claims 84-85** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1) in view of Roussel et al (US 6599614 B1).

**Regarding claims 84-85**, Ruppel teaches compound sheets made of absorbent paper as in the rejection of claim 63 above. Ruppel is silent to a web material wound in a manner to form a roll, said web material on a roll having a first pattern of the first outer surface composed of decorative elements positioned symmetrically to a straight line parallel to a longitudinal axis of the roll.

However, Roussel teaches a web roll form (column 5, lines 54-59) as well as having external plies with patterns and different pitches in the direction of advance and in the transverse direction (symmetric)(column 5, lines 29-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to roll the absorbent paper of Ruppel in a manner identical to that presently claimed, to include embossments symmetric about a longitudinal direction of a roll, as it is ubiquitously known in the art to provide absorbent paper as disclosed in the Ruppel invention in such as manner.

18. **Claim 125** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ruppel et al. (US 6287676 B1).

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**Regarding claim 125**, Ruppel teaches compound sheets made of absorbent paper (multi-ply web material) (abstract) comprising sheets (1) and (2) (1<sup>st</sup> and 2<sup>nd</sup> ply) having deep embossing patterns (3) (1<sup>st</sup> and 2<sup>nd</sup> pattern...protuberance projecting inward) having a density of 3 to 19 bosses/cm<sup>2</sup> and a cross section of an oval, circle etc. (column 2, lines 42-52), which said density and emboss height provides improved touch, flexibility and appearance (column 1, lines 38-45).

As set forth in MPEP 2144.05, in the case where the claimed range “overlap or lie inside ranges disclosed by the prior art”, a prima facie case of obviousness exists, In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Ruppel continues to teach that a third sheet (third ply) can be sandwiched between (interposed) the two embossed sheets without exceeding the scope of the invention (column 2, lines 65-67), while figure 2 (see also column 3, lines 1-3) of the disclosed invention demonstrates that the embossments (3) of sheet (1) are arranged in a staggered manner with the embossments (3) of sheet (2), and that the tips of the of the two sheets (first adhesive, corresponding protuberances' areas of the 1<sup>st</sup> and 2<sup>nd</sup> decorative elements) are coated with glue (column 1, lines 33-37).

The applicants' attention is directed to figure 2 of Ruppel, wherein it is noted that the embossments (3) of sheet (1) and sheet (2) are staggered in an alternating fashion respective to one another, and that the third sheet sandwiched between said sheets (1) and (2) would necessarily be bonded, via the aforementioned glue applied to the tips, to the sheets (1) and (2) in an alternating manner as presently claimed.



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The examiner notes that the embossments (3) of sheets (1) and (2) are an oval cross section and a circular cross section (see column 2, lines 42-52), respectively, would also teach first decorative elements and second decorative elements that are different in shape from each other as presently claimed. It is noteworthy (see In re Seid below) that a choice between said cross sections would be obvious to the skilled artisan.

Claim limitations relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art (In re Seid 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

The examiner also notes that the intercalated manner of the embossments (3) of the reference would necessarily teach that the areas of a second ply corresponding to areas of a first ply having an embossment would be devoid of a protuberance as presently claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to select a density of embossments (3) identical to that presently claimed, which said embossments (3) of the two outer sheets (1) and (2) having different cross sectional shapes, towards an absorbent paper of compounded sheets providing improved touch, flexibility and appearance as in the present invention.

### **Response to Arguments**

19. Applicant's arguments, see pages 20-23, filed 5/4/2010, with respect to the restriction of claim 126 having been constructively elected by original presentation have been fully considered but they are not persuasive.

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The applicants argue that claim 126 is directed to the elected multi-ply web material as is evident from the overlap of the subject matter of elected claims 63-85 and claim 126. The applicants assert that each of claims 63-85 and 126 are directed to a multi-ply web comprising at least three plies joined to one another by adhesive, with a third ply interposed between the outer first and second plies, said first and second plies composed of first and second decorative elements, respectively, with each element formed of protuberances and having a density of three elements/cm<sup>2</sup>.

The applicants also assert that the additional limitations of claim 126 would be similar to limitations added to claim 63 to further limit the embodiment of claim 63. The applicants further assert that the MPEP states, in support of the arguments, that restriction is only proper when the inventions are independent or distinct and a serious burden on the examiner exists if the restriction were not required.

The examiner respectfully disagrees. The applicants' arguments are on the ground(s) that the previous Office Action did not establish an undue search burden of the claims as specified by MPEP 803. This is not found persuasive because the instant application is a national stage entry filed under 35 U.S.C. 371 and is therefore not subject to US restriction practice but rather subject to lack of unity practice, see MPEP 1893.03(d).

It is noted that an undue search burden is not a criterion in lack of unity analysis. The test is whether or not special technical features can be established. Contrary to the applicants' assertions that the additional limitations of claim 126 would be similar to limitations added to claim 63 to further limit the embodiment of claim 63, it is noted that claim 126 requires that the

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claimed second decorative elements are devoid of adhesive, which is not required by the elected invention; indeed, claim 66 requires that a second adhesive is applied to the second decorative elements.

Further, the elected invention now requires intercalation of the first and second decorative elements, which distinguishes the invention of claim 63 over the Roussel reference, while claim 126 does not require such a distinction.

Finally, claim 1126 requires that the first and second elements are different in shape from each other while claim 63 does not require this specific distinction. Thus, claim 126 does not share a special technical feature with the elected invention that is distinguished over the prior art, and there is lack of unity between the elected invention(s) and that of claim 126.

### **Response to Arguments**

20. Applicant's arguments, see pages 27-34, filed 5/24/2010, with respect to the rejection of claims 63-68, 76, 79-82 and 84-85 over Roussel et al. under 35 U.S.C. 102(b); the rejection of claims 69-74 over Roussel et al. in view of Laurent et al. under 35 U.S.C. 103(a); the rejection of claim 75 over Roussel et al. in view of Graff et al. under 35 U.S.C. 103(a); the rejection of claims 77-78 Roussel et al. in view of Hollenberg et al. under 35 U.S.C. 103(a); and the rejection of claim 83 over Roussel et al. in view of Biagiotti under 35 U.S.C. 103(a) have been considered but are moot in view of the new ground(s) of rejection.

The applicants' attention is directed to the prior art rejections set forth above, all of which employ the Ruppel reference as the primary reference. The applicants have focused their current

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arguments against the Roussel reference for not disclosing the presently claimed intercalation or density limitations, and further that the Biagiotti and Hollenberg references do not remedy the deficiencies of Roussel.

However, note that while Roussel, Biagiotti and Hollenberg references do not disclose all the features of the present claimed invention, Roussel, Biagiotti and Hollenberg are used as teaching references, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather these references teach certain concept(s) as set forth above, and in combination with the primary reference, discloses the presently claimed invention.

21. Applicant's arguments, see pages 24-25, filed 5/24/2010, with respect to the rejection of claims 63-85 under 35 U.S.C. 112, 1st paragraph for "the first ply and the second ply are adhesive-bonded to one another" have been fully considered but they are not persuasive.

The applicants have amended claim 63 to overcome the rejection set forth in paragraph 6 of the previous action; however, the currently claimed still requires the 1<sup>st</sup> and 2<sup>nd</sup> plies to be adhesive-bonded together, which is not supported by the specification as originally filed; only that the two said plies are bonded to the third interposing ply.

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### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK D. DUCHENEAUX whose telephone number is (571)270-7053. The examiner can normally be reached on M-Th, 7:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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